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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,468	10/03/2003	Angela J. Keeney	NLF-0323	3346

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EXAMINER	
MCAVOY, ELLEN M	
ART UNIT	**PAPER NUMBER**
1764	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/678,468	KEENEY ET AL.	
	Examiner	Art Unit	
	Ellen M. McAvoy	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are still provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/678,547. Although the conflicting claims are not identical, they are not patentably distinct from each other because the functional fluid comprising a base oil having the properties of (a) a VI of greater than 130, (b) a pour point of about –35°C or lower, and (c) a measured to theoretical low temperature viscosity, and at least one additive; and the product functional fluid prepared by a certain process, may be the same as that claimed in the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants argue that:

"all the independent claims have been amended to include a pour point of less than –35°C. The claims now have a novel limitation over copending Application No. 10/678,547."

This is not deemed to be persuasive because a functional fluid comprising a base stock or base oil having a pour point of about –10°C or lower in the co-pending application is not patentably distinct from the functional fluid comprising a base stock or a base oil in this application because –35°C is lower than –10°C. Further, product by process claims 2, 3 and 4 are essentially identical to product by process claims 3, 4 and 5 of the co-pending application.

Claim Rejections - 35 USC § 112

Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1 and 13, it is not clear that property (b), the pour point, is –35°C or lower. The claims, as amended, appear that the previous pour point value of -10 is struck through, i.e., ~~10~~ and that the pour point now claimed is 35°C or lower, and not –35°C or lower which is what applicants intended. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-21 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al (6,620,312).

Applicants' arguments filed 30 March 2007 have been fully considered but they are not persuasive. As previously set forth, Murphy et al ["Murphy"] disclose a method for producing lube basestocks from waxy feeds including slack wax, Fischer-Tropsch wax, waxy raffinates and waxy distillates to produce a high quality lube oil product having a unique structural character, a low pour point, a low viscosity, and a high viscosity index (VI). The method comprises the steps of (a) hydrotreating the feed to reduce the sulfur and nitrogen contents, (b) hydroisomerizing a portion of the feed to reduce the wax content, (c) separation of the feed, and (d) hydrocatalytic dewaxing at least a portion of the feed from step (c). See column 1, line 37 to column 2, line 18. Properties of a typical product are set forth in Table 7 wherein VI values range from 137-139 and pour point values range from –25°C to –27°C. The examiner is of the position that the premium synthetic lubricants of Murphy appear to meet the limitations of the functional fluid and of the process for preparing the functional fluid of the claims. Applicants' invention differs in independent claims 1 and 13 by including property (iii) "a ratio of measured-to-theoretical low-temperature viscosity equal to about 1.2 or less, at a temperature of about –30°C or lower, where

the measured viscosity is cold-crank simulator viscosity and where theoretical viscosity is calculated at the same temperature using the Walther-MacCoull equation". Although the premium synthetic lubricants of Murphy are not characterized by such values, the examiner is of the position that the claimed function fluids may be the same as those disclosed in Murphy since the properties of VI and pour point may be the same, and since the claimed functional fluid may be prepared by the same process.

Applicants argue that:

> "The prior art does not disclose the importance of hydrodewaxing with a dewaxing catalyst in combination with the other steps to produce a lubricating oil with the claimed properties. Applicants have submitted an expert affidavit with comparative data to support this argument. The prior art cited by the Examiner is not an enabling disclosure of the invention since a person skilled in the art would not know how to produce a lubricant with the claimed properties without the benefit of Applicant's disclosure." And that "In addition, the prior art does not disclose a functional fluid with a pour point of less than –35°C. The closest prior art to this limitation has a pour point of less than –18°C which is significantly higher than –35°C. In addition, the reference does not disclose an specific pour points near or below –35°C."

This is not deemed to be persuasive because Murphy does disclose in columns 9-10 formulated blends containing the inventive base stocks having viscosity indices ranging from 219 to 233 and pour points ranging from –46°C to –68°C which meet the limitations of the claims. Murphy teaches that the products are formulated as an automatic transmission fluid (ATF) using Hitec 434 (Ethyl Corp.) in a ratio of oil to adpack of 3 to 1 by weight. The functional fluids of the claims are open-ended ("comprising") which includes the addition of blend stocks, and applicants teach in the specification on page 27 that the inventive functional fluids may be used with co-base stocks including natural oils, mineral oils and synthetic oils. The process steps of

the claims "comprise" (open-ended) (a) hydrotreating, (b) stripping, (c) hydrodewaxing with a dewaxing catalyst and, optionally, (d) hydrofinishing. As set forth above, Murphy teaches the same process steps and Murphy teaches that suitable dewaxing catalysts include zeolites ZSM-22, ZSM-23, ZSM-35 and ZSM-48 which are some of the same dewaxing catalysts disclosed by applicants. Thus the examiner maintains the position that the functional fluids and the methods of making the functional fluids of the claims appear to be taught by Murphy. Although the measured-to-theoretical low-temperature value is not taught by Murphy, since the functional fluids and methods appear to be the same, this value is also seen to be the same or similar.

The rejections of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,475,960), Berlowitz et al (6,080,301) and Bertomeu (6,599,864) made in the previous office action are withdrawn in view of the amendments made to the claims. Specifically, the functional fluids of the claims now require a base stock or base oil having a pour point is about –35°C or lower which does not appear to be disclosed in these prior art references.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
June 11, 2007